

(9200)

~~9200~~ DAC

PATENTS

IN THE U.S. PATENT AND TRADEMARK OFFICE

In re Application of:

Docket No. 20565-0111

Say-Kyoung Ow et al.

Serial No. 09/121,152

Filed: July 22, 1998

For: Biological De-Inking Method

Assistant Commissioner for Patents  
Washington, D.C. 20231  
Sir:

RECEIVED  
OCT 12 1999  
SPECIAL PROGRAMS OFFICE  
DAC FOR PATENTS

RECEIVED  
OCT - 7 1999  
OIP/E/JCWS

Transmitted herewith is a paper in the above-identified application.

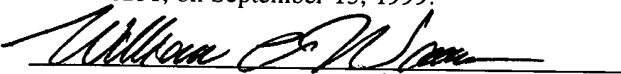
- ☒ Petition to Withdraw Holding of Abandonment and Suspension of Rules Regarding Terminal Disclaimer (Check in the amount of \$130).  
☒ Change of Correspondence Address.

- ☐ No additional fee is required.  
☐ The additional fee is calculated as shown below:

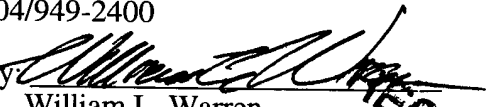
		SMALL ENTITY		OTHER THAN SMALL ENTITY	
	CLAIMS REMAINING AFTER AMENDMENT	HIGHEST PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE	ADDIT. FEE
TOTAL	MINUS	20 =		\$9	\$
INDEP.	MINUS	3 =		\$39	\$
FIRST PRESENTATION OF					
<input type="checkbox"/> MULTIPLE DEPENDENT CLAIMS				+130	\$
TOTAL ADDITIONAL FEE				\$	\$

- ☒ The Commissioner is hereby authorized to charge any additional fees required under 37 CFR §1.16, or credit any overpayment, to Account No. 10-1215. A duplicate copy of this sheet is enclosed.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on September 13, 1999.

  
William L. Warren - Reg. No. 36,714

JONES & ASKEW, LLP  
2400 Monarch Tower  
3424 Peachtree Road, NE  
Atlanta, Georgia 30326  
404/949-2400

By   
William L. Warren  
Reg. No. 36,714

RECEIVED  
SEP 21 1999  
OFFICE OF PETITIONS  
DEPUTY AC PATENTS

Office mailing date. Due to Patent and Trademark Office mailing error, this petition is filed twelve days later than the two month deadline of September 1, 1999.

***Petition to Withdraw Holding of Abandonment***

Applicants respectfully request that the Petition to Withdraw Holding of Abandonment be granted. Under MPEP §711.04(c), a Petition to Withdraw a Holding of Abandonment may be granted when a reply to an Office action is mailed to the Office with a certificate of mailing declaration as part thereof but was not received by the Office. In support of Applicants' Petition to Withdraw the Holding of Abandonment, it is shown that a Notice of Abandonment was mailed July 1, 1999 based on examiner's allegation that no reply was received from applicant in response to a Notice to File Missing Parts mailed by the Patent and Trademark Office on August 14, 1998. [Exhibits A, B]. However, as shown in Exhibit C Applicant did file a complete and timely response within the two month deadline to the Patent and Trademark Office Notice to File Missing Parts of Application on October 14, 1998 which was received by the Patent and Trademark Office on October 19, 1998 [Exhibit D]. Because Applicant did in fact timely respond to Examiner's Notice to File Missing Parts and such communication was in fact received by the Office, Examiner's Notice of Abandonment was improper. Therefore, the Notice of Abandonment should be withdrawn.

***Petition to Suspend Rules Regarding Terminal Disclaimer***

Applicant respectfully requests the Commissioner of Patents to suspend the rules regarding filing a terminal disclaimer with a Petition to Withdraw Notice of Abandonment when the petition is filed outside of the two month deadline. Under MPEP § 711.03(c), a terminal disclaimer is required when a Petition to Withdraw a Holding of Abandonment is filed more than two months

from the mailing date of the Notice of Abandonment. However, under CFR rule 1.183, the Commissioner or Commissioner's designee may waive the terminal disclaimer requirement.

In support of this request to waive the terminal disclaimer requirement applicant notes that along with the fact that the Notice of Abandonment was improper, it was mailed to the wrong attorney of record. The current attorney of record is Jones & Askew, LLP in Atlanta, Georgia. Jones & Askew, LLP has been the attorney of record since the filing of a power of attorney with the Office on February 5, 1996. [Exhibit E]. Applicants also note that this new power of attorney was also submitted to the Patent and Trademark Office on October 14, 1998 with the Response to Missing Parts. Both the Notice to File Missing Parts and the Notice of Abandonment were mailed by the Office to the former attorney of record Browning Bushman Anderson & Brookhart in Austin, Texas on August 14, 1998 and July 1, 1999 respectively – two and a half years after Jones & Askew, LLP filed its power of attorney. While the Notice to File Missing Parts was quickly forwarded by the former attorney of record to Jones & Askew, LLP, the Notice of Abandonment was not received until thirty-four days after the Patent and Trademark office's mailing date. [Exhibits F, G].

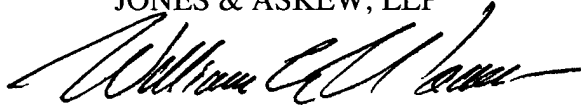
It is inequitable to force an applicant to file a seventy-four day terminal disclaimer when the applicant received a Notice of Abandonment thirty-four days after the Patent and Trademark Office mailed the notice to an incorrect address. The standard for suspending the rules under CFR §1.184 is “an extraordinary situation, when justice requires.” This is such a case. Jones & Askew, LLP took reasonable steps to ensure that all correspondence from the Patent and Trademark Office was directed to its office in Atlanta. Without the granting of this Petition to Suspend Rules Regarding Terminal Disclaimer applicant would be forced to dedicate to the public a term equal to the period between the mail date of the Notice of Abandonment and the filing date of the Petition to Withdraw the Holding of Abandonment. That period would equal seventy-four days. When considering the long delay caused by the Patent and Trademark Office in mailing the

Notice of Abandonment to the incorrect mailing address and the former attorney of record in their delay in forwarding the Notice of Abandonment to Jones & Askew, LLP, it is apparent that applicant has acted promptly by filing the Petition to Withdraw a Holding of Abandonment only twelve days late. Applicants respectfully request that the Patent Office withdraw the holding of abandonment and suspend the rules regarding terminal disclaimer.

A check for \$130.00 is included for the cost of the Petition to Suspend Rules Regarding Terminal Disclaimer. No additional fees are believed due however, the Commissioner is authorized to charge deposit account 10-1215 for any deficiencies.

Respectfully submitted,

JONES & ASKEW, LLP

A handwritten signature in black ink, appearing to read 'William L. Warren', is written over the printed name.

By: William L. Warren  
Reg. No. 36,714

2400 Monarch Tower  
3424 Peachtree Road, NE  
Atlanta, GA 30326  
404/949-2400

Our File: 20565-0111